

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

SPORTVISION, INC.,

NO. C 04-03115 JW

Plaintiff,

v.

SPORTSMEDIA TECHNOLOGY  
CORPORATION,

Defendant.

**ORDER GRANTING SPORTSMEDIA'S  
MOTION TO MODIFY PARTIAL  
SUMMARY JUDGMENT ORDER**

Plaintiff Sportvision, Inc. ("Plaintiff") initiated this lawsuit against Defendant SportsMEDIA Technology Corporation ("Defendant") for patent infringement, trademark infringement and unfair competition. At issue are the rights to a virtual yellow first-down line used in football game broadcasts. On August 4, 2005, the Court granted Defendant's motion for partial summary judgment on the trademark issues (Counts IV, V, and VI of Plaintiff's complaint) ("MSJ Order") (Docket No. 201) because the Court found that Plaintiff Sportvision "failed to offer sufficient evidence to create a genuine issue of material fact that its mark is not functional" (MSJ Order at 12:6-7.) and that "no likelihood of confusion exists between the parties' virtual first-down line services." (*Id.* at 15:24-25.)

Presently before the Court is Defendant's Motion to Modify Partial Summary Judgment Order requesting that Plaintiff Sportvision's trademark registration be cancelled under 15 U.S.C. § 1119 (Count Five in Defendant's counterclaim) (Docket No. 210). Section 1119 provides that "[i]n any action involving a registered mark the court may determine the right to registration, order the

1 cancellation of registrations, in whole or in part. . . .” A trademark registration must be canceled if the  
2 mark is functional. See Gracie v. Gracie, 217 F.3d 1060, 1065-66 (9th Cir.2000) (stating that “[i]n  
3 cases not involving jury trials, district courts have been reversed for refusing to order the cancellation  
4 of registrations for claimed marks found to be incapable of serving as valid marks”).

5 A hearing on Defendant’s motion was set for October 3, 2005. However, the Court finds it  
6 appropriate to take the motion under submission without oral argument pursuant to Civil Local Rule  
7 7-1(b). Based on the arguments advanced by counsel in their briefs, and in light of the Court’s finding  
8 that Plaintiff’s trademark is functional, Defendant SportsMEDIA’s motion is granted.

9 Accordingly, the Court hereby modifies the MSJ Order granting Defendant SportsMEDIA’s  
10 Motion for Partial Summary Judgment to include an order for cancellation of U.S. Trademark  
11 Registration No. 2,622,916.<sup>1</sup>

12 Dated: October 5, 2005

13 04cv3115modify

/s/James Ware

JAMES WARE

United States District Judge

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26 <sup>1</sup> The Court notes that Defendant, in its Motion for Partial Summary Judgment, requested the  
27 Court to cancel Plaintiff’s Trademark Registration No. 2,622,916. The Court inadvertently failed to  
28 expressly include such cancellation in its prior order.

1 **THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:**

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**Dated: October 6, 2005**

**Richard W. Wieking, Clerk**

**By: /s/JW Chambers**  
**Ronald L. Davis**  
**Courtroom Deputy**